

Application No.: 10/081,642

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Claim 21 has been amended to recite more specifically the removal of R⁷ groups set forth in the claim to overcome the §112, second paragraph rejection.

Claims 21, 26, and 28-32 are rejected as allegedly anticipated by or obvious over Rehse, Friderichs, Allen, Itoh, Liu, von Angerer I, von Angerer II and Matsuoka. Applicants respectfully traverse each of these rejections.

The cited references describe the conversion of a methoxy group on an indole structure into an hydroxy group. Neither the starting materials nor the reaction products of the present claims are, however, disclosed or suggested as admitted by the Examiner. The Examiner, however, takes the position that the use of a known reaction for generating novel products from novel starting material does not substantiate a patentable invention.

It is respectfully submitted that the claims recite novel starting materials and novel products, and claim a method that is a patentable invention. Further, it is respectfully submitted that the compounds disclosed in the cited references differ substantially from the compound in the present application. Particularly, the compounds of the prior art references do not appear to contain substituents corresponding to R¹ or A(CO)NHR⁵ as required by the present claims. Also, according to Liu, no conversion occurs. According to Itoh and Rehse, different products are obtained. Thus, the rejections should be withdrawn.

The Examiner is also referred to MPEP Section 2116.01, discusses the case law surrounding the Examiner's rejection. In making such a rejection, all the limitations of a claim must be considered when weighing the differences between the claimed invention and the prior art in determining the obviousness of a process or method claim. See MPEP § 2143.03. In *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996) the Federal Circuit addressed the issue of whether an otherwise conventional process could be patented if it were limited to making or using a nonobvious product. In both cases, the Federal Circuit held that the use of per se rules is improper in applying the test for obviousness under 35 U.S.C. § 103(a); rather, 35 U.S.C. § 103(a) requires a

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highly fact-dependent analysis involving taking the claimed subject matter as a whole and comparing it to the prior art." A process yielding a novel and nonobvious product may nonetheless be obvious; conversely, a process yielding a well-known product may yet be nonobvious." *TorPharm, Inc. v. Ranbaxy Pharmaceuticals, Inc.*, 336 F.3d 1322, 1327, 67 USPQ2d 1511, 1514 (Fed. Cir. 2003). To support a rejection under 35 U.S.C. § 103(a), however, the Examiner must review the collective teachings of the prior art which must suggest to one of ordinary skill in the art that, at the time the invention was made, the claimed invention would have been obvious. In applying this test to the claims on appeal in *Ochiai and Brouwer*, the court held that there simply was no suggestion or motivation in the prior art to make or use novel, nonobvious products in the claimed processes, and, consequently, the court overturned the rejections based upon 35 U.S.C. § 103(a).

Interpreting the claimed invention as a whole requires consideration of all claim limitations. Thus, proper claim construction requires treating language in a process claim which recites the making or using of a nonobvious product as a material limitation. Motivation to make or use the nonobvious product must be present in the prior art for a 35 U.S.C. 103 rejection to be sustained. The decision in *Ochiai* specifically dispelled any distinction between processes of making a product and methods of using a product with regard to the effect of any product limitations in either type of claim.

As noted in *Brouwer*, 77 F.3d at 425, 37 USPQ2d at 1666, the inquiry as to whether a claimed invention would have been obvious is "highly fact-specific by design". Accordingly, obviousness must be assessed on a case-by-case basis. The MPEP discloses the following decisions as illustrative of the lack of per se rules in applying the test for obviousness under 35 U.S.C. § 103(a) and of the fact-intensive comparison of claimed processes with the prior art: In *re Pleuddemann*, 910 F.2d 823, 15 USPQ2d 1738 (Fed. Cir. 1990) (Methods of bonding polymer and filler using a novel silane coupling agent held patentable even though methods of bonding using other silane coupling agents were well known because the process could not be conducted without the new agent); In *re Kuehl*, 475 F.2d 658, 177 USPQ 250 (CCPA 1973) (Process of cracking hydrocarbons using novel zeolite catalyst found to be patentable even though catalytic cracking process was old. "The test under 103 is whether in view of the prior art the invention as a whole would have been obvious at the time it was made, and the prior art here does not include

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the zeolite, ZK-22. The obviousness of the process of cracking hydrocarbons with ZK-22 as a catalyst must be determined without reference to knowledge of ZK-22 and its properties." 475 F.2d at 664-665, 177 USPQ at 255.); and In re Mancy, 499 F.2d 1289, 182 USPQ 303 (CCPA 1974) (Claim to a process for the production of a known antibiotic by cultivating a novel, unobvious microorganism was found to be patentable.). Thus, to the extent the Examiner has cited case law which allegedly supports the rejection, there is ample case law supporting Applicant's position.

Furthermore, in applying this test of Ochiai and Brouwer to the presently pending claims, it is respectfully submitted that there is no suggestion or motivation in the prior art to make or use novel, nonobvious products in the claimed processes, and the Examiner has not specifically pointed to such motivation. Furthermore, it is respectfully submitted that the Examiner has not engaged in the type of intensive, fact specific analysis required to make such a rejection. Therefore, the Examiner is respectfully requested to withdraw the rejection over the cited references.

The Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-0624, under Order No. NY-HUBR 1203.2-CONT-US. A duplicate copy of this paper is enclosed.

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Respectfully submitted,

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